

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT F. LASSITER

Appeal No. 1998-2129
Application No. 08/561,816

ON BRIEF

Before, WARREN, WALTZ, and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-7 and 18, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a building cover material, such as a roofing underlayment that includes a plurality of nail tabs placed at spaced intervals thereon. An

understanding of the invention can be derived from a reading of exemplary claims 1 and 18, which are reproduced below.

1. A roofing material of the type generally applied to roofs prior to the application of roofing shingles, comprising saturated underlayment material, and a plurality of nail tabs made of a thermoplastic or thermosetting material formed at spaced intervals by depositing said tabs onto the surface of said saturated underlayment material in a liquid state, which subsequently solidifies and bonds to said saturated underlayment material.

18. A building cover material of the type generally applied prior to the application of a finishing covering, comprising a flat sheet or board covering material for covering studs spaced at predetermined regular intervals, and a plurality of nail tabs made of a thermoplastic or thermosetting material formed at spaced intervals by disposing said tabs onto the surface of said covering material in a liquid state, which subsequently solidifies and bonds to said covering material.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Meeker 1985	4,554,196	Nov. 19,
Zerfass et al. (Zerfass) 14, 1992	5,130,178	Jul.

In addition, the examiner relies on several claims of the following patent as evidence of obviousness type double patenting:

Lassiter	Re. 35,603	Sep. 16, 1997
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Claim 18 stands rejected under 35 U.S.C. § 102(b) as anticipated by Meeker. Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zerfass in view of Meeker. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10 and 21 of Lassiter (Re. 35,603) in view of Meeker.

OPINION

We refer to the appellant's brief and to the answer for the opposing viewpoints expressed by appellant and the examiner concerning the above noted rejections. For the reasons which follow, we will not sustain the examiner's §§ 102(b) or 103(a) rejections as expressed in the answer. However, we shall sustain the rejection of claims 1-7 over claims 1, 10 and 21 of Lassiter in view of Meeker based on the judicially created doctrine of obviousness-type double patenting.

As our initial inquiry into a review of the examiner's rejections under 35 U.S.C. § 102(b) and § 103(a), we must analyze the claim language to determine the scope and meaning of each contested limitation. See Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). We give the terms of the appealed claims their ordinary meaning unless we find that another meaning is intended by appellant. See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1996). Here, we observe that the claims on appeal require that a surface of a covering material (claim 18) or the surface of an underlayment material (claims 1-7) has deposited thereon a plurality of nail tabs. We determine that the ordinary meaning of the term "tab" as used in appellant's claims requires that the tabs have been deposited in a manner so as to be in contact with the surface of the covering or underlayment as a "projection, flap or short strip" on the surface.¹ This interpretation is consistent

¹ See the definition of "tab" at page 1176 of Webster's II New Riverside University Dictionary, The Riverside Publishing Company (1984). A copy of that dictionary page is attached to the decision.

with the requirement that the claims of the application be given the broadest reasonable interpretation consistent with the specification as they would be construed by one of ordinary skill in the art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). In this regard, we note the description in the specification at page 5, line 31 through page 7, line 4 thereof indicates that the tabs are in contact with but raised above the surface of the covering material or underlayment.

Rejection under § 102(b)

The examiner has the initial burden of establishing a prima facie case of anticipation by pointing out where all of the claim limitations are described in a single reference. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). This the examiner has not done.

Rather, the examiner essentially urges that the fibrous product of Meeker that includes permeated material (30, figures 2 and 3) meets the structure of claim 18. We disagree. The product specified in claim 18 requires a plurality of nail tabs made of thermoplastic or thermosetting material. As we noted above, such nail tabs constitute protrusions on the surface of a covering material. In our view, the single area (30, figures 2 and 3) in which a molten thermoplastic material permeates and solidifies in the fibrous product of Meeker does not constitute a teaching of a single tab let alone a plurality of surface protrusions or tabs as required by that appealed claim. Hence, the examiner has simply not carried the initial burden of establishing a prima facie case of anticipation as to appealed claim 18.

Consequently, we reverse the rejection under 35 U.S.C.

§ 102(b).

Rejection under § 103(a)

The roofing material products specified in each of claims 1-7 require a plurality of nail tabs made of thermoplastic or thermosetting material. Like the Meeker patent discussed above, the additionally applied Zerfass patent simply does not teach or suggest such nail tabs as herein claimed.

Recognizing this deficiency of the teachings of the Zerfass patent, the examiner turns, once again, to Meeker (answer, page 4) in a futile attempt to supply evidence establishing the obviousness of the claimed nail tabs. However, for reasons noted above, our review of Meeker reveals that the thermoplastic resinous material portion of the fibrous product described in that patent does not make up for the lack of a teaching of a plurality of nail tabs in Zerfass.

From our perspective, the examiner has not satisfactorily explained why one of ordinary skill in the art would have been led to modify the product of Zerfass in light of the teachings of Meeker so as to arrive at the herein claimed roofing material product containing nail tabs. In this regard, the

examiner has not convincingly established how the teachings of Meeker (column 1, lines 20-23 and 45-68) with respect to forming a hardened resin permeated portion in a fibrous product for holding an insert for a screw fastening device coupled with the teachings of Zerfass (column 2, lines 3-16) regarding the formation of a particular support web for roofing membranes that is reported as having good nail pull out resistance would have led one of ordinary skill in the art to effect a modification in the support web product of Zerfass so as to arrive at the claimed product including nail tabs. On this record, we reverse the stated rejection over the combined teachings of those references.

Obviousness-type Double Patenting Rejection

We note that in obviousness-type double patenting rejections, the analysis employed parallels the guidelines for analysis of a § 103 obviousness determination. See In re Longi, 759 F.2d 887, 892-93, 225 USPQ 645, 648 (Fed. Cir. 1985). Accordingly, the question this appeal presents requires us to decide whether claims 1-7 on appeal herein encompass a roofing material product containing a plurality of

nail tabs which would not have been patentably distinct from the product of claims 1, 10 and 21 of Lassiter (R.E. 35,603) taken with the teachings of Meeker. A review of each of claims 1, 10 and 21 of Lassiter (R.E. 35,603) reveals that a roofing material including a plurality of nail tabs secured thereto is required in each of those claims. Here, we agree with the examiner that it would have been prima facie obvious to one of ordinary skill in the art to form the nail tabs of claims 1, 10 and 21 of Lassiter (R.E. 35,603) using a thermoplastic or thermosetting material since such plastic materials are known to harden and form a secure base for holding a fastening device as generally suggested by Meeker. While appealed claims 1-7 describe the product at least partially in terms of the method by which it is made, we observe that the finished product not the method of making the product, is the focus of our inquiry since the patentability of such claims is determined based on the product itself. See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) ("If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim

is unpatentable even though the prior art product was made by a different process."). Where, as here, appellant's product and that of claims 1, 10 and 21 of Lassiter (R.E. 35,603) appear to be substantially identical, the burden shifts to appellant to provide evidence that the applied product of claims 1, 10 and 21 of Lassiter (R.E. 35,603) does not necessarily or inherently possess the relied upon characteristics of appellant's claimed product. See In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977); In re Fessmann, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. See In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977); In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). Appellant discusses method differences but has not persuasively argued in the brief, let alone established with objective evidence, how the products of the appealed claims 1-7 are patentably distinguished over the product of claims 1, 10 and 21 of Lassiter (R.E. 35,603) alone or the product of

claims 1, 10 and 21 of Lassiter (R.E. 35,603) as modified based on the teachings of Meeker as applied by the examiner in combination therewith. Accordingly, we shall sustain the examiner's rejection of claims 1-7 under the judicially created doctrine of obviousness-type double patenting over claims 1, 10 and 21 of Lassiter (R.E. 35,603) in combination with Meeker.

Other Issues

Prior to final disposition of this application and/or in the event of any other further prosecution of the subject matter of this application, the examiner should determine whether an obviousness-type double patenting rejection of claim 18 over any of the claims of Lassiter (R.E. 35,603) would also be appropriate with or without additional prior art. In this regard, we also note that claims 4 and 13 of Lassiter (R.E. 35,603), which claims describe plastic tab material should be particularly considered by the examiner in considering an obviousness-type double patenting rejection of appellant's claims in the event of further prosecution.

CONCLUSION

The decision of the examiner to reject claim 18 under

35 U.S.C. § 102(b) as anticipated by Meeker and to reject claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over Zerfass in view of Meeker is reversed. The decision of the examiner to reject claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10 and 21 of Lassiter (Re. 35,603) in view of Meeker is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

CHARLES F. WARREN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Administrative Patent Judge)	

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APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

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DECISION: **ED**

Prepared By:

DRAFT TYPED: 25 Oct 02

FINAL TYPED: